

ESTTA Tracking number: **ESTTA347881**

Filing date: **05/17/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

|                           |   |
|---------------------------|---|
| Proceeding                | 92051945  |
| Party                     | Plaintiff<br>ChoiceStream, Inc.   |
| Correspondence<br>Address | Phi Lan M. Tinsley<br>K&L Gates LLP<br>State Street Financial Center, One Lincoln Street<br>Boston, MA 02111<br>UNITED STATES<br>tmboston@klgates.com, philan.tinsley@klgates.com |
| Submission                | Answer to Counterclaim  |
| Filer's Name              | Phi Lan M. Tinsley  |
| Filer's e-mail            | tmboston@klgates.com, philan.tinsley@klgates.com  |
| Signature                 | /philan m. tinsley/   |
| Date                      | 05/17/2010  |
| Attachments               | ChoiceStream Cancellation-Answer to Counterclaim.pdf ( 5 pages )(383322<br>bytes )  |

1. ChoiceStream is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 26.

2. ChoiceStream is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 27.

3. To the extent that the records of the U.S. Patent and Trademark Office (“USPTO”) accurately reflect RichRelevance’s Registration No. 3,471,575, such records speak for themselves. ChoiceStream is without knowledge or information sufficient to form a belief as to the truth of the other allegations contained in the remainder of paragraph 28.

4. To the extent that the records of the USPTO accurately reflect RichRelevance’s trademark application Serial No. 77/745,840, such records speak for themselves. ChoiceStream is without knowledge or information sufficient to form a belief as to the truth of the other allegations contained in the remainder of paragraph 29.

5. ChoiceStream admits the averments contained in paragraph 30.

6. ChoiceStream admits that Exhibit A of RichRelevance’s Counterclaim purports to show printouts of screenshots from ChoiceStream’s website, [www.choicestream.com](http://www.choicestream.com). ChoiceStream denies the allegations contained in the remainder of paragraph 31.

7. ChoiceStream admits to the averments in paragraph 32, in particular that it owns U.S. Registration No. 3,378,718 for the mark REALRELEVANCE in International Class 42 for “providing online non-downloadable software for use by retailers and online entertainment providers in providing goods and services that are customized to user preferences.” ChoiceStream further admits that it submitted an application on August 22, 2006 that matured into U.S. Registration No. 3,378,718 for the mark REALRELEVANCE in International Class 42 on February 5, 2008.

8. ChoiceStream admits to the averments in paragraph 33, in particular that it owns U.S. Registration No. 3,657,301 for the mark REALRELEVANCE in International Class 35 for “[t]argeted advertising services, namely, promotion of the goods and services of others by means of a global computer network; [a]dvertising services, namely, promoting the goods and services of others by providing recommendations based on consumer’s click and purchase data; promoting the goods and services of others by providing a web site at which users can link to information pertaining to the goods and services offered by advertisers; dissemination of advertising matter; dissemination of advertising matter for others via the Internet ” ChoiceStream admits that it submitted an application on December 23, 2008 that matured into U.S. Registration No. 3,657,301 for the mark REALRELEVANCE in International Class 35 on July 21, 2009.

9. ChoiceStream denies the allegations contained in paragraph 34.

10. ChoiceStream denies the allegations contained in paragraph 35.

11. ChoiceStream avers that the WHEREFORE paragraphs of the Counterclaim do not contain any allegations requiring a response, however to the extent that the Trademark Trial and Appeal Board finds that the paragraph contain allegations, Choicestream denies it.

#### AFFIRMATIVE DEFENSES

12. RichRelevance’s Counterclaim Petition to Cancel fails to state a claim on which relief can be granted.

13. RichRelevance’s Counterclaim Petition to Cancel ChoiceStream’s trademark registrations is baseless and has been brought in bad faith.

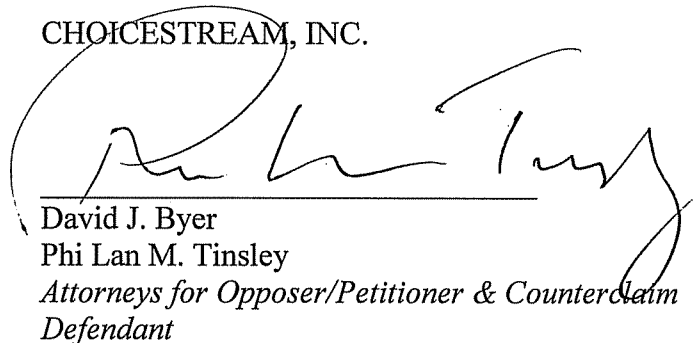
14. RichRelevance's Counterclaim Petition to Cancel ChoiceStream's trademark registrations are barred in whole or in part due to ChoiceStream's priority use, filing and registration dates.

15. RichRelevance's Counterclaim Petition to Cancel ChoiceStream's trademark registrations is without merit and barred in whole or in part due to the absence of actual or likely confusion as to the nature, origin, source, sponsorship or affiliation with ChoiceStream's registered trademarks.

16. RichRelevance is not entitled to the relief it seeks because of the doctrine of unclean hands.

Date: May 17, 2010

CHOICESTREAM, INC.

A large, stylized handwritten signature in black ink, likely belonging to David J. Byer, is written over a horizontal line. The signature is fluid and cursive, with a large loop at the end.

David J. Byer  
Phi Lan M. Tinsley  
*Attorneys for Opposer/Petitioner & Counterclaim  
Defendant*  
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### **CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the ANSWER OF COUNTERCLAIM DEFENDANT CHOICESTREAM, INC. TO REGISTRANT'S COUNTERCLAIM PETITION TO CANCEL was served this 17<sup>th</sup> day of May 2010, by First Class Mail, postage prepaid, upon:

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